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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/940,755  
Filing Date: August 28, 2001  
Appellant(s): DESHPANDE, NIKHIL M.

\_\_\_\_\_  
Robert E. Mates, Reg. No. 35271  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12/19/2005 appealing from the Office action mailed 7/14/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. However, the appellant has not explicitly stated which claims stand or fall together. Thus, in addition to the statement in the brief: The examiner notes that claims 1-11

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and 22-24 stand or fall together as is construed from the appellant's argument beginning on page 11 of the brief. The examiner notes that claims 12-21 and 25 stand or fall together as is construed from the appellant's argument on page 13 of the brief under the heading "Claims 12, 17, 18, and 25".

### **NEW GROUNDS OF REJECTION**

After further consideration of the claims, a new ground of rejection has been determined. Claims 22-25 are rejected under 35 U.S.C. 101. The rejection will be discussed in detail in section (9) below.

### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

### **(8) Evidence Relied Upon**

|           |              |        |
|-----------|--------------|--------|
| 6,798,358 | JOYCE ET AL. | 9-2004 |
| 6,714,793 | CAREY ET AL. | 3-2004 |

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-6 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Method claims 1-6 are directed to a method comprising two steps of sending a first message from a location and receiving a second message.

In order to be statutory under § 101, method claims must be tied to a machine or transform an article into a different state or thing. Here, the method claim is neither expressly tied to a machine nor does it transform an article to a different state or thing. For example, the claims do not recite a machine that perform the sending or receiving steps nor do the claimed limitations transform an article different state or thing. Claims 1-6 are therefore directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joyce et al. (U.S. Patent Number 6,798,358), hereinafter referred to as Joyce, in view of Carey et al. (U.S. Patent Number 6,714,793), hereinafter referred to as Carey.

In considering claims 1, 13, and 19, Joyce discloses a location-based content delivery system and method comprising:

sending a first immediate message from a location, wherein the first immediate message comprises a request for information (see Joyce col. 7, lines 25-30); and

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receiving a second immediate message, wherein the second message comprises a response to the request, wherein the response is dependent on the location (see Joyce col. 7, lines 66-67 through col. 8 line 1).

While Joyce discloses that the mobile terminal may query the server via a SMS message, Joyce does not explicitly disclose that the messages are instant or immediate messages. Nonetheless instant message communication among wireless and non-wireless environments is well known as evidenced by Carey. In similar art, Carey discloses a system and method for instant message communication in a wireless and non-wireless environment wherein messages are sent from a mobile unit device over a wireless communication network (col. 1, lines 60-65). Given the teachings of Carey, it would have been obvious to a person having ordinary skill in the art to modify the system disclosed by Joyce to include instant messaging capabilities in order to provide subscribers with the benefits of real-time communication on a constantly open communication channel not only in hardwired Internet systems but also in a wireless environment. It would be advantageous to communicate via instant text message because text messaging as compared to voice communications is less costly since it utilizes less bandwidth, and is more efficient than playing phone tag or waiting for e-mail replies. See Carey, col. 1, lines 47-58. Accordingly, text instant messaging is an efficient cost effective way of communicating. Therefore the aforementioned limitation would have been an obvious modification to the system disclosed by Joyce.

In considering claims 2, 15, and 20-21, the combined system of Joyce and Carey discloses that the first immediate message further comprises sending the first immediate message to a user name identified in a buddy list (see Carey col. 8, lines 8-18).

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In considering claims 4 and 22, the combined system of Joyce and Carey discloses a system and method comprising:

receiving a first instant message from a sender (see Joyce col. 7, lines 25-30);  
determining a location of the sender (see Joyce col. 7, lines 30-39); and  
sending a second instant message to the sender, wherein the contents of the second instant message are dependent on the location of the sender (see Joyce col. 7, lines 40-59, lines 66-67 through col. 8, line 1, and lines 19-22).

While Joyce discloses the system substantially as claimed, Joyce does not disclose that the messages that are delivered are instant messages. Nonetheless instant message communication among wireless and non-wireless environment is well known as evidenced by Carey. In similar art Carey discloses a system and method for instant message communication in a wireless and non-wireless environment wherein messages are sent from a mobile unit device over a wireless communication network (col. 1, lines 60-65). Given the teachings of Carey, it would have been obvious to a person having ordinary skill in the art to modify the system disclosed by Joyce to include instant messaging capabilities in order to provide subscribers with the benefits of real-time communication not only in hardwired Internet systems but also in a wireless environment. It would be advantageous to communicate via instant text messages because it is less costly and it utilizes less bandwidth. See Carey, col. 1, lines 47-58. Therefore the aforementioned limitation would have been an obvious modification.

In considering claims 5, 11, and 23, the combined system of Joyce and Carey discloses that the method further comprises:

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parsing contents of the first instant message to determine a meaning of the contents (see Joyce col. 7, lines 30-39), wherein the contents of the second instant message are further dependent on the meaning (col. 7, lines 46-59).

In considering claims 6 and 24, the combined system of Joyce and Carey discloses the method further comprising:

finding information related to the meaning of the contents of the first instant message (see Joyce col. 7, lines 30-35); and building the contents of the second instant message based on the information (col. 7, lines 46-59).

In considering claim 7, the combined system of Joyce and Carey discloses a server, comprising:

data indicating a location of a mobile device (see Joyce col. 3, lines 65-67 through col. 4, lines 1-2); and

a personal-assistance controller to send information to the mobile device, wherein the information is based on the location of the mobile device (col. 7, lines 40-59 and col. 8, lines 19-22).

In considering claims 8, 14, and 16, the combined system of Joyce and Carey discloses wherein the mobile device (see Carey Fig. 1 (36)) is connected via a long-lived connection (30, public or private network) to the instant-messaging server (40).

In considering claim 9, the combined system of Joyce and Carey discloses wherein the personal-assistance controller (application server, 18) is to send an instant message to the mobile device, wherein the instant message comprises the information (see Joyce col. 7, lines 55-59, lines 66-67).



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In considering claim 10, the combined system of Joyce and Carey discloses a location database comprising the location of the mobile device and the information, wherein the information is specific to the location (see Joyce col. 3, lines 65-67 through col. 4, lines 1-2).

In considering claim 25, the combined system of Joyce and Carey discloses that the location of the sender comprises a location of a hotspot access point (see Joyce Fig. 1 wireless communication network, 12).

In considering claims 12 and 17, the claims contain limitations substantially the same as those previously rejected in claims 1, 4, and 7. Therefore the same grounds of rejection are applicable. Additionally the hotspot access point is functionally equivalent to the wireless communication network 12.

In considering claim 18, the combined system of Joyce and Carey discloses that the personal-assistance controller is to determine the location of the one of the plurality of hotspot-access points via the presence data (see Joyce col. 36-40).

The following ground of rejection is a new ground of rejection:

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 22-25 recite descriptive material that may or may not be an embodiment of a computer system or embodied on a computer readable medium so as to be

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executable. Here, “a signal-bearing media” does not does not suffice as computer readable and does not constitute eligible subject matter for patentability. See MPEP 2106.IV.B.1.

The applicant’s specification defines a signal-bearing media in terms of both statutory and non-statutory embodiments. See the specification, page 10, line 22 through page 11, line 11. The “communications media” embodiment is considered non-statutory as a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. A claim that can be read so broadly as to include statutory and non-statutory subject matter must be amended to limit the claim to a practical application.

#### **(10) Response to Argument**

In the brief, the applicant has argued:

- <Argument 1>

There exists no motivation to combine Joyce and Carey.

- <Argument 2>

There exists no reasonable expectation of success of the combination of Joyce and Carey.

- <Argument 3>

The combination of Joyce and Carey does not disclose all of the features of claim 12 and like claims because it does not disclose “a hotspot-access point” as recited in the claims.

Argument 1 appears to be directed to claims 1-11 and 22-24 as stated above in section (6) and discusses claim 1 as exemplary. See pages 11-12 of the brief. In response to argument 1, it is maintained that there exists motivation to combine Joyce and Carey. The rejection clearly

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cites motivation to combine Joyce and Carey stating advantages of communicating via instant text message such as “text messaging as compared to voice communications is less costly since it utilizes less bandwidth.” This motivation comes expressly from the prior art. See Carey, column 1, lines 47-58. This same paragraph cites a clear need in the art for utilizing instant messages in a wireless system as Carey states “There exists a need to provide the benefits of instant messaging outside of hardwired Internet systems.” The appellant is well aware of these examples of motivation to combine the references as stated explicitly in Carey. They were clearly pointed out by the examiner and discussed with the appellant in detail in the telephone interview conducted 10/7/2005. See the interview summary dated 10/14/2005.

In discussing the above cited paragraph of Carey in the brief, the appellant states that “Carey compares instant messaging with text messaging,” however this is not the case. It appears that the appellant has either misinterpreted Carey or is trying to confuse the issue at hand. Carey defines the benefits of instant messaging as “immediate knowledge of another online status and real-time text communication.” See Carey, column 1, lines 50-53. Carey discusses prior art instant messaging systems such as AIM that allow for both presence information of another user and communication with other users via text messages. As is well known in the art, and as is disclosed by Carey, an instant message is a text message between users of an instant messaging system. Carey is in fact comparing text-based messages (including instant messages) to voice communications when discussing the cost of bandwidth and resources. Carey’s purpose is to add instant messaging to a wireless environment and thus he makes comparisons to known wireless devices such as cell phones that (before Carey’s advancements) transferred mainly voice data and not real-time text data. Nowhere throughout

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Carey's disclosure does he attempt to distinguish between an instant message and a text message. Instant messages are in fact text-based.

Argument 2 appears to be directed to claims 1-11 and 22-24 as stated above in section (6) and discusses claim 1 as exemplary. See pages 11-12 of the brief. In response to argument 2, it is maintained that there exists a reasonable expectation of success when combining Joyce and Carey. As previously discussed, Joyce discloses a wireless communications network for content delivery to mobile devices while Carey discloses a similar wireless network that utilizes instant messaging between mobile devices. Joyce's wireless system uses such devices as mobile telephones and PDAs. As already described in relation to argument 1, this is the type of system into which Carey wishes to bring instant messaging capabilities. Again, see Carey, *inter alia*, column 1, lines 47-58. The fact that Carey's intent is to bring instant messaging into a wireless system such as is disclosed by Joyce is clear evidence of a reasonable expectation of success for the combination. One of ordinary skill in the art working with wireless networks would clearly understand the wireless network as set forth in Joyce and would further clearly understand how to introduce instant messaging into such a system as it is described by Carey.

Further it is noted that MPEP 2143.02 discusses in detail "Reasonable Expectation of Success". MPEP 2143.02 primarily deals with the chemical and biotechnological arts wherein there is an inherent level of unpredictability when combining prior art teachings. The electrical and computer arts are considered to have a high level of predictability. In predictable arts, the burden is on the applicant to show evidence that there is no reasonable expectation of success. Here, the appellant has failed to show sufficient evidence of there being no reasonable

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expectation of success as the appellant only makes a conclusive statement to this view without providing specific evidence. Given the purposes of Joyce and Carey in addition to the detailed discussions of relevant wireless systems set forth in their disclosures, as well as the high level of predictability in the art, the examiner maintains the existence of clear evidence of a reasonable expectation of success for the combination. The appellant has set forth no evidence that would support an opposing position.

Argument 3 appears to be directed to claims 12-21 and 25 as stated above in section (6) and discusses claim 12 as exemplary. See page 13 of the brief. In response to argument 3, it is maintained that the combination of Joyce and Carey discloses the limitation of “a hotspot-access point” as recited in claim 12 and like claims. The rejection clearly sets forth Joyce’s wireless communication network (figure 1, item 12) in meeting the limitation at hand. See the paragraphs concerning claims 25, 12, and 17 in section (9) above. Any wireless communication network must in fact maintain access points, otherwise there is no communication and the system is no longer a communication network. An access point is a point in a wireless coverage area from which the mobile device can communicate with the network. If the mobile device is outside of the coverage area, it cannot access the network (i.e. it cannot receive a signal and therefore cannot effectuate communications) and thus is not in range of an access point. In discussing his wireless communication network, Joyce clearly states that a mobile device is serviced by a wireless communication network via a proximate base station and that a base station provides communications within a given area, here referred to as a cell. See Joyce, *inter alia*, column 3, lines 6-15. This is how wireless networks work.

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Further, it is unclear why the appellant believes the combination does not meet the limitation at hand. The appellant has simply set forth a conclusive statement and has not provided any reason as to how he feels the claimed “hotspot-access point” distinguishes over the prior art. As is well known in the art, a hotspot is simply another word for an access point within a coverage area, and thus reciting “a hotspot-access point” does not distinguish the claim over any access point in Joyce’s coverage areas, or cells. The claims make no attempt to further define how this “hotspot-access point” may be different from any ordinary hotspot or access point as they are known in the art of wireless networks. Further, the appellant’s specification does not further define how this “hotspot-access point” may be different from any ordinary hotspot or access point as they are known in the art of wireless networks. On page 3, lines 8-10, the specification sets forth an exemplary embodiment which states that “a hotspot may be a wireless access point electronic device strategically located for providing wireless mobile devices, such as mobile device 140, access to network 110.” In this case, each of Joyce’s base stations in his wireless communication network clearly satisfies the appellant’s description of a hotspot. Again, see Joyce, column 3, lines 6-15.

For the above reasons, it is believed that the rejections should be sustained.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

### **Conclusion**

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

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Respectfully submitted,

/Dohm Chankong/  
Primary Examiner, Art Unit 2452

Dated: August 7, 2009

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

Conferees:

/John Follansbee/  
Supervisory Patent Examiner, Art Unit 2451

/Bunjod Jaroenchonwanit/  
Supervisory Patent Examiner, Art Unit 2456